

REMARKS

Claims 16-37 are pending in the present application. Claims 16, 23, 29, 36 and 37 are independent claims. Claims 36 and 37 are new claims. Claims 16, 23 and 29 are amended. No new matter is involved.

Support for the amendment and for new claims 36 and 37 is found throughout Applicant's original disclosure including, for example, in Figs. 1 and 2 and the portions of the specification describing those figures.

Rejections under 35 USC §103

Claims 16-35 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 5,786,845 to Tsuria in view of U.S. Patent 5,907,321 to Grossman. This rejection is respectfully traversed.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the Applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In doing so, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore

Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Tsuria is directed to providing messages in the form of “advertisements” which are disclosed as “preferably in the form of slides accompanied by voice data.” – see col. 3, lines 54-57, for example.

Tsuria contains no disclosure or suggestion of (1) providing icons, as recited; or (2) providing an icon on the screen during a time gap in digital television channel switching to facilitate identification of the selected channel, as recited.

The Office Action, apparently realizing the shortcomings of Tsuria, turns to Grossman to combine with Tsuria.

Grossman is directed to providing advertising information or commercial value, such as a corporate logo, trademark or text message, or a public service nature – see col. 3, lines 35-45, for example. In the preferred embodiment, the advertisement is sent from the cable headend to be displayed on the TV set – see col. 3, lines 53-55, for example.

Grossman contains no disclosure or suggestion of providing an icon on the screen during a time gap in digital television channel switching to facilitate identification of the selected channel, as recited.

Neither Tsuria nor Grossman is directed to facilitating identification of a selected channel, as is the claimed invention. This is an important distinction between the claimed invention and the applied art, and is a feature that is positively recited in all of the claims, i.e., in channel switching apparatus claims 16-22, in digital television claims 23-27, and in channel switching method claims 29-35. In this regard, it is noted that the facilitating channel identification feature is found in the preamble and in the body of all three sets of claims and is a positively recited feature of all of the claims.

The Court of Appeals for the Federal Circuit has stated that whether to treat claim preamble language as a positively recited claim limitation is “resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” Corning Glass Works v. Sumitomo Electric USA, Inc., 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). The Court also stated that “Clear reliance on the preamble during prosecution to distinguish the claimed invention from prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention.” Catalina Marketing International v. Coolsavings.com, Inc., 62 USPQ2d 1781, 1785 (Fed. Cir. 2002); Bristol-Meyers Squibb Co. v. Ben Venue Labs., Inc., 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

In this case, Applicant not only positively recites “to facilitate channel identification” in the claim preambles, but also recites this feature in the body of the claims, and clearly states in lines 7-11 of the main body of the Specification that the present invention relates to a channel switching apparatus and method capable of making identification of a channel easier. Accordingly, it is abundantly clear, that this feature of facilitating channel identification has to be given patentable weight in the examination of this patent application.

However, instead of doing just that, the Office Action appears to give this feature no patentable weight, stating that “it is a redundant description.” In this regard, the Office Action states that “the purpose of and reason for

creating a logo unique to a product or company is exactly for readily identifying that product or logo.” Applicant respectfully submits that this assertion fails to address the claimed invention.

The disclosure in Grossman of displaying a corporate logo is completely devoid of any suggestion of displaying something that would facilitate channel identification, as claimed. The concept of displaying something to facilitate channel identification is completely missing from both of the applied references, as well as from the definition of “logo.”

Even if one were to display a broadcasting company’s corporate logo, that alone would not necessarily mean that the broadcasting company logo was associated with the channel on which it was displayed. In this regard, Applicant respectfully submits that cable TV companies advertise on network television stations and *vice versa*.

The only teaching of displaying something to facilitate channel identification is found in Applicant’s disclosure. It is not found in Tsuria, it is not found in Grossman, and it is not found in the definition of “logo.”

As neither applied reference, nor the newly cited definition of “logo” even suggests providing an icon on the screen during a time gap in digital television channel switching to facilitate identification of the selected channel, the basis for providing an icon on the screen during a time gap in digital television channel switching to facilitate identification of the selected channel must be speculation and/or impermissible hindsight based solely on Applicant’s

disclosure, both of which are improper grounds for rejecting claims under 35 USC §103(a).

With respect to the comments in the Advisory Action, Applicant respectfully submits that by focusing on what teachings allegedly are not precluded by the applied art, the Office is admitting that what is claimed is not taught or suggested by the applied art. With respect to the "NBC peacock," the Office does not explain what specific channel is identified by the "NBC peacock." NBC has numerous channels with respect to which it is associated and advertises on numerous channels other than NBC owned or affiliated channels. Bearing this in mind, one of ordinary skill in the art would not find it obvious to achieve the claimed invention, which positively recites selecting a channel icon that facilitates identification of the selected channel. Nor would one conclude that Office has made out a prima facie case of obviousness of the claimed invention.

Accordingly, the Office Action has not made out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of pending claims 16-35 is respectfully requested.

NEW CLAIMS 36 AND 37

New claim 36 recites a method which is clearly not taught or suggested by the applied art and claim 37 recites an apparatus which is clearly not taught or suggested by the prior art. Support for these claims is found

throughout Applicant's originally filed disclosure, including drawing Figs. 1 and 2 and the associated description of those figures in the specification.

CONCLUSION

In view of the above comments, all of the pending claims are allowable over the prior art of record, and an early issuance of a Notice of Allowance is respectfully requested.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Registration No. 46,472, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
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